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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,217	08/02/2005	Takashi Yamazaki	064446-0015	9488
20277 7590 09/23/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER DONDERO, WILLIAM E				
ART UNIT		PAPER NUMBER		
3654				
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09/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/544,217

**Applicant(s)**

YAMAZAKI ET AL.

**Examiner**

WILLIAM E. DONDERO

**Art Unit**

3654

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2008 and 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikegami et al. (US-4015785) in view of Sasaki et al. (US-5558296). Regarding Claim 1, Ikegami et al. disclose an apparatus for winding a wire comprising an annular guide 10 for guiding the wire, the guide has an inner peripheral surface 10a whose diameter gradually increases (as shown by the angled portion in Figure 6) in a direction away from a take-up bobbin 1, and movably positioned to cover one of a plurality of collars 5 of the take-up bobbin for the wire, and having an engagement portion (corner of inner peripheral wall 10 where cut wire, shown by dashed line, contacts inner peripheral wall 10a) on and extending from the inner peripheral surface

for preventing the wire from spring out of the bobbin (Figure 6). Ikegami et al. is silent about the annular guide having a notch. However, Sasaki et al. discloses an annular guide 24 with a notch 24a for guiding a wire onto a take-up bobbin 12 (Figures 1, 6, 8, 10; Column 8, Lines 29-32). Because both Ikegami et al. and Sasaki et al. teach devices for guiding the cut wire into the guide, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the notch of Sasaki et al. for the guide 9 of Ikegami et al. to achieve the predictable result of guiding the wire into the guide and onto the bobbin as taught by Sasaki et al (Column 8, Lines 29-32) while eliminating a moving part which could fail. Regarding Claim 3, Ikegami et al. disclose the annular guide is disposed so that it is moveable (by actuator 13) in an axial direction of the bobbin (Figures 1 and 6). Regarding Claim 5, Ikegami et al. disclose the apparatus comprises a wire positioning device 9 for guiding the cut terminal portion of the wire (Figure 6). Regarding Claim 6, Ikegami et al. disclose the wire positioning device comprises a guide rod (vertical portion of 9) for moving the wire and a guide plate (horizontal portion of 9) for preventing the spring of the wire (Figure 6).

With respect to Claim 8-9, the method described in these claims would inherently result from the use of the annular guide apparatus of Ikegami et al. in view of Sasaki et al. as advanced above.

### ***Response to Arguments***

With regards to Applicant's arguments starting on page 4, line 14 to page 6, line 16, Applicant argues Ikegami et al. does not disclose or suggest an engagement portion extending from the inner peripheral surface of the guide. Applicant's arguments with

respect to claims 1, 3, 5-6, and 8-9 have been considered but are moot in view of the new ground(s) of rejection. Further it is noted that the engagement portion of Ikegami et al., the corner of the inner peripheral surface 10a at which the cut wire, shown by the dashed line, is on and extends from the inner peripheral surface inasmuch as Applicant's engagement portion extends from the inner peripheral surface of the annular guide.

With respect to Applicants arguments starting on page 7, line 17 to page 9, line 5, Applicant argues Ikegami et al. in combination with Sasaki et al. does not disclose or suggest an annular guide having a notch and an engagement portion extending from or on the inner peripheral surface. Applicant's arguments have been fully considered but they are not persuasive. As addressed in the preceding paragraph, Ikegami et al. does disclose an engagement surface on and extending from an annular peripheral surface of the guide. Furthermore, substituting the notch of Sasaki et al. for the guide of Ikegami et al. will achieve the predictable result of guiding the wire into the guide and onto the bobbin while eliminating a moving part which could fail.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM E. DONDERO whose telephone number is (571)272-5590. The examiner can normally be reached on Monday through Friday 6:30 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. E. D./

Examiner, Art Unit 3654

/Peter M. Cuomo/

Supervisory Patent Examiner, Art Unit 3654